

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAAKI AIHARA

Appeal No.1997-1873
Application 08/300,855¹

HEARD: DECEMBER 7, 1999

Before FLEMING, RUGGIERO, and HECKER, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 8, all of the claims pending in the present application.

¹ Application for patent filed September 6, 1994.

The invention relates to a method for judging whether or not an engine is in a steady state operation during which the monitoring for diagnosis is performed.

Independent claim 1 is reproduced as follows:

1. A method of judging a steady state operation of an engine by monitoring at least one engine parameter for a predetermined period of monitoring, comprising:

turning on an ignition switch and starting said engine;

detecting an engine parameter;

memorizing an initial value of said engine parameter at the start of said period of monitoring;

calculating a difference between said initial value of said engine parameter and said detected engine parameter;

discontinuing monitoring if said difference is outside of a predetermined restriction width before the end of said period of monitoring; and

judging that said engine is in a steady state operation if said difference is within a predetermined restriction width at the end of said period of monitoring.

The Examiner relies on the following references:

Kay et al. (Kay)	4,691,288	Sept. 1, 1987
Matsuno	5,297,047	Mar. 22, 1994
		(filed July 5, 1991)

The Appellant's specification is objected to under 35 U.S.C. § 112, first paragraph for failing to provide an enabling disclosure of a diagnosis method.

Claims 6 through 8 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons stated in the objection to the specification.

Claims 1 through 3 and 6 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kay.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kay in view of Matsuno.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief² and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 8 under 35 U.S.C. § 103.

The Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). We note that our reviewing court states that "when determining obviousness, the claimed invention should be

² Appellant filed an appeal brief on May 20, 1996. Appellant filed a reply brief on October 7, 1996. We note that the record does not show that the Examiner considered or entered this reply brief. In the normal course of events we would have remanded the appeal back to the Examiner to have a statement on the record of whether the Examiner considered and entered the reply brief. However, we decided to proceed with the appeal for judicial economy. Therefore, we will not consider the reply brief as being properly before us.

Appeal No. 1997-1873
Application 08/300,855

considered as a whole; there is no legally recognizable 'heart' of the

invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *cert denied*, 519 U.S. 822 (1996), *citing W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983). *cert. denied*, 469 U.S. 851 (1984).

On pages 14 through 16 of the brief, Appellant argues that Kay does not teach or suggest determining a steady state engine condition. We note that Appellant's claim 1 recites a method of judging a steady state condition comprising the step of discontinuing monitoring if the difference is outside a predetermined restriction width before the end of said period of monitoring and judging that the engine is in a steady state operation if the difference is within a predetermined restriction width at the end of said period of monitoring. We note that Appellant's claim 6 also recites a diagnosing method of an engine comprising the steps of discontinuing said diagnosis if said difference is outside said range, judging that said engine is operated in a steady state if the difference is within the range and continuing said diagnosis while said steady state exists. We note that the only remaining independent claim, claim 8, recites similar language of determining the steady state of an engine. On page 6 of the answer, the Examiner states that Kay does teach in column 6, line 8, determining the steady state of the engine by the comparison of the speed to a reference. On page 2 of the answer, the Examiner states that Kay teaches a method of judging a steady state operation of the engine pointing us to the abstract.

Upon our close review of Kay, we fail to find that Kay has any teachings of determining whether an engine is in the steady state position. We agree with the Examiner that Kay states in column 6, lines 8 through 12, that the adjustment procedure is based on the presumption that, under steady state operation conditions, the flywheel speed at the end of each firing interval should be the same as at the beginning of that interval. However, we do not agree that Kay teaches a determination of a steady state operating condition as recited in Appellant's claims. Kay simply teaches that they are presuming that the engine is under a steady state condition, but does not teach any method of determining how to determine whether the engine is in a steady state operating condition.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kay in view of Matsuno. We fail to find that Matsuno closes the gap as well. Matsuno does not teach the method steps as recited in Appellant's claims of determining whether an engine is at the steady state. Therefore, we will not sustain the Examiner's rejection of claims 1 through 8 under 35 U.S.C. § 103.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as not providing an enabling disclosure of the claimed invention. In particular, the Examiner argues that the specification does not disclose any details of diagnosis of an engine. Claims 6 through 8 stand rejected under 35 U.S.C. § 112, first paragraph, for the reasons stated in the objection to the specification.

On pages 7 and 8 of the appeal brief, Appellant argues that the specification does in fact

disclose that the method for determining the steady state operation of an engine according to the invention is part of a larger diagnosis method. Appellant points to page 8, lines 5 through 17, of the specification which expressly states that the first step of the diagnosis of an engine is to determine whether the engine is under a steady state operation.

In order to comply with the enablement provision of 35 U.S.C. § 112, first paragraph, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 303 (CCPA 1974); *In re Brandstadter*, 484 F.2d 1395, 1404, 179 USPQ 286, 293 (CCPA 1973); and *In re Gay*, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962). If the Examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the Appellant to come forward with evidence to rebut this challenge. *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973), *cert. denied*, 416 U.S. 935 (1974); *In re Brown*, 477 F.2d 946, 950, 177 USPQ 691, 694 (CCPA 1973); and *In re Ghiron*, 442 F.2d 985, 992, 169 USPQ 723, 728 (CCPA 1971). However, the burden was initially upon the Examiner to establish a reasonable basis for questioning the adequacy of the disclosure. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and *In re Armbruster*, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975).

Upon our review of the specification, we find that the disclosure would have adequately

described the claimed invention so that the artisan would have been able to practice it without undue experimentation. In particular, we find that the specification clearly points out that the determination of the steady state condition of the engine is the first step in many different types of well-known diagnostic processes of the engine.

Therefore, we will not sustain the Examiner's rejection of claims 6 through 8 under 35 U.S.C. § 112, first paragraph.

We have not sustained the rejection of claims 1 through 8 under 35 U.S.C. § 103, nor have we sustained the rejection of claims 6 through 8 under 35 U.S.C. § 112, first paragraph.

Accordingly, the Examiner decision is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
STUART N. HECKER)	
Administrative Patent Judge)	

MRF/dal

Appeal No. 1997-1873
Application 08/300,855

BEVERIDGE DE GRANDI WEILACHER
and YOUNG
1850 M STREET, N.W.
STE. 800
WASHINGTON, DC 20036